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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/307,356	05/07/1999	WILLIAM ALLAN	91436-171	4713
35437	7590	03/18/2005	EXAMINER	
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO 666 THIRD AVENUE NEW YORK, NY 10017			HSU, ALPUS	
			ART UNIT	PAPER NUMBER
			2665	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/307,356

Applicant(s)

ALLAN ET AL.

Examiner

Alpus H. Hsu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,29,30,32,33 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1-4,30,32,33 and 39 is/are rejected.
- 7) ☒ Claim(s) 40 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. Applicant's arguments with respect to claims 1-4, 30, 32, 33 and 39 have been considered but are moot in view of the new ground(s) of rejection.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the call service provider as in claims 1, 32 and 39, the control messenger as in claim 32, and the messenger within the call service provider, all must be clearly shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claims 1-4, 32, 33, 39-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed subject matter of a network intelligence for a data network, comprises a call service provider and data network telephones as in claim 1, a network intelligence for a data network, comprises a call service provider and a control messenger as in claim 32, and a network intelligence for a data network, comprises a call service provider comprising a messenger as in claim 39, were only recited in summary of invention (page 2, lines 8-19), but were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Focsaneanu et al. in U.S. Patent No. 5,610,910 (newly cited).

Referring to claim 1, Focsaneanu et al. discloses a network intelligence for a data network, comprising: a call service provider (200) for, when connected to a plurality of data network telephones (CPEs), facilitating provision of telephony services for the plurality of telephones; and one or more terminal emulators each comprising at least one service proxy (208) for, when connected to a plurality of data sources, setting up services between the plurality of data sources and the plurality of telephones (see column 7, lines 10-47, column 7, line 67 to column 8, line 10).

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Referring to claim 2, Focsaneanu et al. disclose the network intelligence further comprising at least one configuration data structure (202) for each of the plurality of data network telephones, each configuration data structure correlating user input elements from a telephone with functions (see column 11, lines 34-45).

Referring to claim 3, Focsaneanu et al. disclose the network intelligence further comprising a plurality of configuration data structures (202s) for each of the plurality of data network telephones, each configuration data structure of a given one of the plurality of telephones correlating user input elements of the given one telephone with functions, different configuration data structures for the given one telephone correlating at least some user input elements of the given one telephone with different functions (see column 11, lines 34-45).

Referring to claim 4, Focsaneanu et al. disclose the user input elements comprise key press indications (see column 7, lines 29-32, 52-55).

Regarding claim 30, Focsaneanu et al. disclose a computer readable medium, which when loaded into a processor connected to a data network to which at least one telephone is also connected, controls said processor to: based on user input messages from said telephone, establish a voice call; based on one or more user input messages from said telephone received during pendency of said voice call, set up at least one non-telephony data service between said telephone and at least one data source, at least where said at least one data service does not conflict with said voice call (see column 10, lines 20-41, column 12, lines 38-50).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Focsaneanu et al. in U.S. Patent No. 5,610,910 (newly cited) in view of Wang et al. in U.S. Patent No. 6,161,134 (of record).

Referring to claims 32 and 33, Focsaneanu et al. disclose a network intelligence for a data network, comprising: a call service provider (200) for, when connected to a plurality of data network telephones, facilitating provision of telephony services for said plurality of telephones (column 7, lines 20-29).

Focsaneanu et al. differ from the claims, they do not disclose a control messenger for selectively sending a control message to enable/disable a user input element of a given telephone of the plurality of telephones to locally control a function at the given telephone, providing the user input element comprises a volume control, which is a well known device and commonly used in communications field for selective control purpose.

Wang et al., for example, from the similar field of endeavor, teaches a control messenger (320 or 343) for selectively sending a control message to enable/disable a user input element of a

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given telephone of the plurality of telephones to locally control a function at the given telephone (see column 18, lines 7-27, column 21, lines 23-57), providing the user input element comprises a volume control (column 22, lines 54-66).

Thus, it would have been obvious to one of ordinary skill in the art to incorporate the control messenger of Wang et al. into the system of Focsaneanu et al. to provide selective control on the data network telephones to further improve the system reliability and efficiency.

9. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Focsaneanu et al. in U.S. Patent No. 5,610,910 (newly cited) in view of Wong et al. in U.S. Patent No. 5,881,103.

Referring to claim 39, Focsaneanu et al. disclose a network intelligence for a data network, comprising: a call service provider (200) for, when connected to a plurality of data network telephones, facilitating provision of telephony services for the plurality of telephones (column 7, lines 20-29).

Focsaneanu et al. differ from the claim, they do not disclose a messenger within the call service provider for sending messages with audio parameters over the data network to the plurality of telephones for controlling audio at the plurality of telephones, the audio parameters including transmission and reception filters, which is also well known device in the art for audio equalization and compensation purposes.

Wong et al., for example, from the similar field of endeavor, teach the use of a processor (206) for sending messages with audio parameters over the data network to the plurality of telephones for controlling audio at the plurality of telephones, the audio parameters including transmission and reception filters (see column 3, lines 20-43).

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Thus, it would have been obvious to one of ordinary skill in the art to incorporate the processor of Wong et al. into the system of Focsaneanu et al. to provide audio signal equalization and compensation to further improve the system quality control.

10. Claim 29 is allowed.

11. Claims 40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Blomfield-Brown, Focsaneanu et al. '666 & '292, Low et al., Low, Schuster et al., and Beyschlag et al. are additionally cited to show the common feature of telecommunications network providing multi-services to telephony devices utilizing call service provider similar to the claimed invention.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHH



Alpus H. Hsu
Primary Examiner
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